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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,685	08/24/2000	Michinori Hirota	36595:165847	2576

7590 03/13/2002

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EXAMINER

CHERUBIN, YVESTE GILBERTE

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,685

Applicant(s)

HIROTA, MICHINORI

Examiner

Yveste G. Cherubin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the communication received on January 3, 2002, in which claims 1-2 are canceled and claims 3-7 are amended.

Allowable Subject Matter

2. The indicated allowability of claim 3 is being withdrawn in view of the newly interpretation of the claims and newly found reference, Dietz, II (US Patent No. 5,704,835). A non-final rejection follows.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- a. Claims 3, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Patent No. 4,715,604 – referred to hereinafter as Okada '604).

As per claim 3 Okada' 604 discloses a slot machine comprising a display and shift or move means for moving or shifting and displaying various kinds of symbols on a set of reels, as shown in Fig 1. During a game, each reel is caused to rotate and is stopped at one of the possible stop positions in each of which it displays corresponding symbols neighboring to each other, as shown in Fig 1, to a player through a window or an easy-viewable profile. When all the reels stop, a win decision is made based on the combinations of symbols stopping on the winning line or lines. Okada '604 failed to disclose the use of symbol marks to form a specified symbol mark and wherein said

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specified symbol mark includes a first semi circular symbol mark formed in the shape of an upper half of a circular configuration and a lower half of a circular configuration to complete a circle in cooperation with a said first semi-circular symbol mark. However, using such configuration to display symbols would have been a matter of design choice. It's known to have half of a watermelon being used as a symbol, having it arranged and displayed in a way to form a circular shape would have been a matter of choice. Honestly, the Examiner does not see the difference between the symbol marks of Okada and the symbol marks of this instant claim limitation since the symbol marks of both devices are applying the same function, which is to display possible winning combinations. Besides, a symbol is a symbol and can be represented by anything one wants it to be and relating or associating that symbol to whatever winning combination to fit one needs would have been a matter of design choice. Whatever symbols one would decide to use to display the different possible winning combinations would only be a matter of design choice. As per claims 6-7, Okada '604 discloses a slot machine comprising of a plurality of rotation reels (see Fig 1), each having various kinds of symbols (see Fig 2), 2:22-28, also see elements (9, 10, 11) in Fig 2.

b. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Patent No. 5,083,785 – referred to hereinafter as Okada '785) in view of Dietz, II (US Patent No. 5,704,835).

As per claims 4-5, Okada '785 discloses a slot machine capable of shifting and displaying symbols as shown in Fig 1. In reference to Fig 2, Okada '785 further

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discloses a random generator (25) that generates at random numerical values included in a series of integers ranging from "1" to "4096"; a random number sampler (26) for sampling the numerical values generated by the random number generator, 3:28-48; a storage means (29) for storing table data having a plurality of predetermined reference values, 3:49-50, 4:1-4; a stop control means (36) for controlling the stop of the shift and display means to have a set of symbols stopped and displayed on the basis of the winning state, 4:5-49. As shown in element (29) of Fig 2, Okada discloses different levels of winning states such as small win, middle or medium win, big win and no win. However, Okada failed to teach more than one small winning state in one game. Dietz, II discloses a slot machine device wherein the symbol arrangement are configured in a way to provide more than one type of winning state in one game. With an understanding of section 5:30-35 and Fig 4, if the random number chosen by the microprocessor were a 34, for example, the full symbol in the upper box would be a "bell", the full symbol in the middle box would be an "orange" (35) and the full symbol in the lower box would be an "orange" (36) therefore having that particular symbol neighboring itself and provide whatever winning state that symbol is associated with on two different lines. The same rule would follow if the random chosen number were 1, or 10 or 36, etc. It would have been obvious to one of ordinary skill in the art to provide the symbol arrangement teaching of Dietz in the Okada type device in order to allow players to win more and therefore attract more players.

Response to Arguments

4. Applicant's arguments with respect to claims 3-7 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner is urging the Applicants to take a close look at the cited references below when writing his response.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. US Patent No. 4,721,307 to Okada which teaches slot machine.
- b. US Patent No. 4,889,339 to Okada which teaches slot machine.
- c. US Patent No. 5,074,559 to Okada which teaches slot machine.
- d. US Patent No. 4,573,681 to Okada which teaches slot machine with random number generation.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

March 8, 2002

ygc



**JESSICA HARRISON
PRIMARY EXAMINER**

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.